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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,718	02/24/2004	Mark Banister	MEDIPACS 04.03	2762
27667	7590	07/27/2010		
HAYES SOLOWAY P.C. 3450 E. SUNRISE DRIVE, SUITE 140 TUCSON, AZ 85718				
EXAMINER				
FREAY, CHARLES GRANT				
ART UNIT		PAPER NUMBER		
3746				
NOTIFICATION DATE		DELIVERY MODE		
07/27/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

admin@hayes-soloway.com  
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**Advisory Action**  
**Before the Filing of an Appeal Brief**

**Application No.**

10/786,718

**Applicant(s)**

BANISTER, MARK

**Examiner**

Charles G. Freay

**Art Unit**

3746

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 16 July 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/Charles G Freay/  
Primary Examiner  
Art Unit: 3746

Continuation of 11, does NOT place the application in condition for allowance because: The Applicant's arguments that the Examiner has misconstrued the teachings of da Costa and Chinn et al in order to make the combination set forth in the Final Rejection, and that improper hindsight has been used, are not found to be persuasive. The Applicant begins his argument by speculating that since the da Costa base reference is directed to a refrigeration compressor the proposed combination set forth in the rejection must be directed to creating a refrigeration compressor. The rejection does not state this nor does the claimed invention require it. Then, absent a teaching of specific pressures in the da Costa reference, the Applicant incorporates operational limits from other devices set forth in the background and prosecution of da Costa as proper pressures for the da Costa device and tries to apply these Applicant assumed pressure operational ranges as the ranges which must be met by the combination. From here the Applicant backtracks what he believes would be proper operational stroke times and pressure levels from the Chinn reference to achieve a performance standard set upon the da Costa pump by the Applicant after assuming these standards from the other structural arrangements described in the prosecution history of the da Costa reference. It is noted that the combination set forth in the Final Rejection was not trying to create a high pressure refrigeration compressor. Furthermore, and most importantly, the claims which are being rejected set forth no limitations upon the pressures which must be obtained, the stroke or actuation time or any other performance type data which must be met. The closest the claimed invention comes to setting forth a performance standard is in an intentional use statement set forth in the preamble of the independent claim. The Examiner has not misconstrued the teachings of the references. The teachings of the references are very clear and relatively simple to one of ordinary skill in the art. The da Costa reference teaches that if plural expandable and contractable actuators are placed in series in a flow path then the series of actuators can pump a fluid if actuated in the correct order. Chinn et al teach that electroactuated polymer gels may be used as reversibly responsive elastomeric actuators in the pump field. For at least these reasons the combination as set forth in the Final Rejection is proper. With regards to the "improper hindsight argument the Examiner has taken into account only knowledge which was within the skill level of one of ordinary skill in the art at the time the invention was made. The Applicant also argued that replacing the actuators of da Costa with Chinn would make the invention completely inoperable. This is not true. A series of Chinn et al actuators placed in a pump chamber as taught by da Costa would still pump fluid. The Applicant also argues that "(t)he Examiner provides no rationale by which Chinn might be otherwise modified". It is noted that the Chinn et al reference is not being modified in the rejection.

The Examiner notes that if the claims included any type of operational parameters or limits which placed any type of requirement on the performance or abilities of the pump then the arguments made may be found more persuasive. However, as set forth the claims are so broad that they do not limit the claimed invention to any particular application or performance standard.